

REMARKS

This communication responds to the Office Action dated May 21, 2008. Claims 151 and 158 are amended, no claims are canceled, and no claims are added. As a result, claims 149-183 are now pending in this Application. It is respectfully noted that claims 151 and 158 have been amended to correct typographical errors, and not for reasons related to patentability.

§103 Rejection of the Claims

Claims 149-183 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rangan et al. (U.S. Patent No. 6,006,265; hereinafter "Rangan") in view of Kingdon et al. (U.S. Patent No. 5,784,560; hereinafter "Kingdon"). However, since a *prima facie* case of obviousness has not been properly established with respect to these references, the Applicant respectfully traverses the rejection of these claims.

1) The Applicable Law

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. See *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S.

App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. See *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

2) Application of § 103 to the Rejected Claims – the References Teach Away from the Suggested Combination

The Office admits that Rangan "does not explicitly teach inheriting user profile attributes into the user profile from a group of which the user is a member and storing the user profile information in a hierarchical attribute value-pair data structure." Office Action, pg. 4. This is the case, even though "Rangan does teach a user being member of a larger group (col. 11, lines 4-17, each SUV is part of a neighborhood)." *Id.* To provide the missing elements, the Office cites Kingdon, at Col. 6, lines 7-33, asserting that "Kingdon teaches a method of inheriting user profile attributes into the user profile from a group of which the user is a member ... and storing the user profile information in a hierarchical attribute value-pair data structure." Office Action, pg. 5.

The Office goes on to assert that it would be obvious to combine Rangan and Kingdon "because Kingdon provides a specific implementation for the broad concept touched (in the form

of neighborhoods) in Rangan. Combining the teachings of inheritance taught by Kingdon with the neighborhood example of Rangan would produce a predictable result.” However, a close reading of Rangan and Kingdon reveals that each reference teaches away from the combination, and that if this combination were implemented, an inoperative system would result.

Rangan teaches the use of hyperlinks that can be interpreted based on previously-expressed preferences. *See* Rangan, Col. 9, lines 5-10. Examples include advertising spots chosen to reflect facts that may be known about the SUV (subscriber/user/viewer). *See* Rangan, Col. 11, lines 4-19. The selection of information that can be accessed may also be based on security information, or past user activity. *See* Rangan, Col. 28, lines 38-58. In other words, Rangan teaches a system that relies on the ability to dynamically update user preference information.

Kingdon, on the other hand, teaches that tampering, or providing access to non-trusted parties that permits changing “important information in the distributed directory” should be prohibited. *See* Kingdon, Col. 3, lines 23-40. To prevent tampering with object attributes, Kingdon describes a system where the attributes, whether inherited or otherwise, are synchronized to enable the use of static attribute resolution in a secure environment. *See Id.* at Col. 4, lines 35-36 and Col. 7, lines 1-45. “...attributes are synchronized when the Security Equals attribute of the first object includes the second object, and the Equivalent To Me attribute of the second object includes the first object.” *Id.*, Abstract.

For example, if the attributes of a user and a printer (as objects) are not in synchronization with each other, then any access to the printer requested by that user will be denied. *See Id.* at Col. 7, line 48 – Col. 8, line 27. In fact, this same example is used by Kingdon to show that access attempts by a user with respect to an object, where the rights to such access have not been previously established, are deemed to be illicit attempts to modify the associated object attributes. *See Id.* at Col. 8, lines 2-3. Thus, even if inheritance is permitted by Kingdon, user activity to modify object attributes is not.

Each of the independent claims recites at least two mechanisms that can operate to change the user profile: (1) user activity; and (2) inheritance. The combination suggested by the Office relies on Rangan to provide user activity profile changes, and Kingdon to provide changes to the user profile via inheritance. However, this overlooks the stated objective of Rangan to

prevent the "illicit modification" of attributes – that is, modification attempted by the user. *See Id.*

Thus, if the use of inheritance, as practiced in the implementation taught by Kingdon, is added to the method of Rangan, an inoperative system results. This is because attempts to incorporate user activity into the user profile are illicit, according to Kingdon, and will be denied. *See Id.* at Col. 8, lines 19-21. If such modifications are prevented, the system of Rangan ceases to provide different interpretations for a hyperlink based on "the previously expressed preferences of the SUV [subscribers/users/viewers]". *See Rangan, Abstract and Col. 9, lines 4-13.*

Indeed, the only mechanism described by Kingdon for establishing attribute values in a system that operates using static resolution of object attributes is that of a system administrator. *See Id.* at Col. 8, lines 42-53. That is, only the system administrator, acting on an *a priori* basis, can set the values of attributes. *See Id.* User activity to change attribute values is simply not permitted. *See Id.* at Col. 8, lines 19-21.

In summary, Rangan teaches away from using a system that prevents user activity from modifying a user profile (e.g., as in Kingdon). Kingdon teaches away from using a system that permits user activity from modify a user profile (e.g., as in Rangan). Thus, it is not obvious to combine these references with each other, as suggested by the Office. Therefore, reconsideration and withdrawal of the rejection under 35 USC § 103 in view of Rangan and Kingdon is respectfully requested.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's representative at (408) 278-4041 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19 day of June, 2008.

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